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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/650,560	08/28/2003	Eric D. Fox	073897.0140	7600

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BAKER BOTTS L.L.P.  
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SUITE 600  
DALLAS, TX 75201-2980

EXAMINER

HENDERSON, MARK T

ART UNIT

PAPER NUMBER

3722

DATE MAILED: 09/22/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. 10/650,560	Applicant(s) FOX, ERIC D.	
	Examiner Mark T Henderson	Art Unit 3722	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 18 June 2004.
- 2a) ☐ This action is **FINAL**.      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,2,6-9,13-18,23,24,31-34 and 39 is/are pending in the application.
- 4a) Of the above claim(s) 3-5,10-12,19-22,25-30,35-38 and 40 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2,6-9,13-18,23,24,31-34 and 39 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>8/03 and 1/04</u> . | 6) <input type="checkbox"/> Other: <u>Attachment I</u> .                                |

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## **DETAILED ACTION**

### **Faxing of Responses to Office Actions**

In order to reduce pendency and avoid potential delays, TC 3700 is encouraging FAXing of responses to Office Actions directly into the Group at (703)872-9306. This practice may be used for filing papers which require a fee by applicants who authorize charges to a PTO deposit account. Please identify the examiner and art unit at the top of your cover sheet. Papers submitted via FAX into TC 3700 will be promptly forwarded to the examiner.

### ***Election/Restriction***

1. Claims 3-5, 10-12, 19, 21, 22, 25-23, 35, 37, and 38 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected inventive species, there being no allowable generic or linking claim. Furthermore, Claims 20 and 36 were also withdrawn, since these claims can not be read on the elected species (Species C, which does not disclose a hinge element). Claim 40 was also withdrawn for being dependent on a non-elected species claim (Claim 28). Election was made without traverse in Paper No. 6/18/04.

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***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 33 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

2. Claim 33 recites the limitation "item" in line 5. There is insufficient antecedent basis for this limitation in the claim. Is the "item" the same as the "insert" stated in Claim 24?

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1, 2, 7, 8, 13, 16, 18 and 34 are rejected under 35 U.S.C. 102(b) as being anticipated by Haddock (4,700,840)- Part A.

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Haddock discloses in Fig. 1-3, a card product and a method of securing an item comprising providing a card (15) having a recess or cavity (B, as stated in Col. 3, lines 15 and 16) operable for receiving and removing an item (47); a slidable cover (13) operable for maintaining or covering the item (47) within the recess; wherein the cavity (A) is disposed on a first face (15A) of the card; a securing mechanism (29, 31, 33, 35, 37, 39, 41, 42) to affix the cover to the card.

4. Claims 1, 2, 7, 13, 16 and 18 are rejected under 35 U.S.C. 102(b) as being anticipated by Haddock- Part B.

Haddock discloses in Fig. 1-3 and Attachment I, a card product and a method of securing an an item comprising providing a card (11) having a recess or cavity (B, as stated in Col. 3, lines 15 and 16) operable for receiving and removing an item (47); a slidable cover (13) operable for maintaining or covering the item (47) within the recess; wherein the cavity (A) is disposed on a first face (15A) of the card; a securing mechanism (29, 31, 33, 35, 37, 39, 41, 42) to affix the cover to the card.

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***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 14 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Haddock.

Haddock discloses an identification card comprising all the elements as claimed in Claims 7 and 13, and as set forth above in Part A and B. However, Haddock does not disclose a groove or recessed portion in the cavity of the card.

In regards to **Claims 14 and 15**, it would have been obvious to one having ordinary skill in the art at the time the invention was made to place the groove or recessed portion at any desirable location on the card, since it has been held that rearranging parts of an invention involves only routine skill in the art. Therefore, it would have been obvious to place the securing groove at any desirable location, since applicant has not disclosed the criticality of groove's location, and invention would function equally as well at any location which will secure the cover to the card as taught by Haddock.

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6. Claims 23, 24, 31-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Haddock in view of Rubincam (4,159,417).

Haddock discloses in Fig. 1-3, an identification card comprising: a card (15) having a recess (A) operable to receive an insert (47); wherein the insert (47) is removable into and removed from the recess (A); a slidable cover (13) operable to maintain the insert within the recess; a securing mechanism which consist of a groove (37 and 39) which is operable with a cover (13) to secure the cover to the card; a distal portion (29, 31, 33, 35) along an edge of the cover (13) operable with the recessed portion or groove (37 and 39) to secure item or insert (47) in the card (15).

However, Haddock does not disclose: an insert coupleable to a picture; and a groove in the recess of the card.

Rubincam discloses in Fig. 3, an insert (30) which coupleable to a picture (32, as stated in Col. 2, lines 47-58).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Haddock's identification card with an insert coupleable with a picture as taught by Rubincam for the purpose of storing the picture in a portable means.

In regards to **Claim 32**, it would have been obvious to one having ordinary skill in the art at the time the invention was made to place the groove at any desirable location on the insert, since it has been held that rearranging parts of an invention involves only routine skill in the art. Therefore, it would have been obvious to place the securing groove at any desirable location,

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since applicant has not disclosed the criticality of groove's location, and invention would function equally as well at any location which will secure the cover to the insert as taught by Haddock.

7. Claims 6 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Haddock (Part B) in view of DeField (5,467,871).

Haddock discloses an identification card comprising all the elements as disclosed in Claims 1 and 16, and as set forth above in Part B. However, Haddock does not disclose wherein a portion or face of the card is transparent to allow the inserted item to be visible through the card.

DeField discloses in Fig. 1A and 1B, an identification card (10) comprising a transparent face portion (Col. 3, lines 29 and 30).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Haddock's card with a transparent face portion as taught by DeField for the purpose of allowing the end user to view the card's contents before extraction.

8. Claims 23 and 39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bolanos (6,427,836) in view of Rubincam.

Bolanos discloses in Fig. 1-4, an identification card (20) comprising a recess (26) operable to receive an insert (25), wherein the insert has a picture (face picture as seen in Fig. 1); and wherein the recess is disposed on a first face of the identification card (seen in Fig. 1 and 2).

However, Bolanos does not disclose wherein the picture is coupled to the insert.



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Rubincam discloses in Fig. 3, an insert (30) which coupleable to a picture (32, as stated in Col. 2, lines 47-58).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Bolanos' card with an insert that is coupleable to the picture as taught by Rubincam for providing an insert having a picture which can be interchangeable.

#### *Prior Art References*

The prior art references listed in the attached PTO-892, but not used in a rejection of the claims, are cited for (their/its) structure. Chin, Perfect, Minami et al, Rupert et al, and Thouin et al discloses similar cards.

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**Contact Information**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark T. Henderson whose telephone number is (703)305-0189. The examiner can be reached on Monday - Friday from 7:30 AM to 3:45 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner supervisor, A. L. Wellington, can be reached on (703) 308-2159. The fax number for TC 3700 is (703)-872-9302. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the TC 3700 receptionist whose telephone number is (703)308-1148.



MTH

September 15, 2004



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